

REMARKS

Claims 1, 4-14, 17-26, 29-31, and 35-42 are pending in the application. The Applicant hereby requests further examination and reconsideration of the application in view of these remarks.

Improper Finality

In paragraph 15, on page 31 of the office action, the Examiner stated that “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL.”

In response, the Applicant notes that the office action contains at least two new grounds of rejection: (1) the rejection of claims 1, 4-13, 36, and 39 under 35 U.S.C. § 101 and (2) the rejection of various claims under 35 U.S.C. § 103 over a newly cited reference (Leeuwen). The Applicant submits that the first of these two new grounds of rejection, i.e., the rejection of claims 1, 4-13, 36, and 39 under 35 U.S.C. § 101, was **not** necessitated by the amendment. This conclusion is clearly supported, for example, by the following two facts: (1) the same § 101 rejection of claim 1 could have been made prior to the amendment and (2) nothing in the newly added claim language appears to make amended claim 1 more susceptible to a § 101 rejection than the previously pending claim 1.

Next, the Applicant directs Examiner’s attention to MPEP § 706.07(a), which **explicitly prohibits** making the rejection final “where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c).” The explicit command of the above-quoted portion of MPEP § 706.07(a) is clear: if there are multiple new grounds of rejection (as in the last office action), then the finality can only be proper when **each and every** new ground of rejection was necessitated by the amendment. By the same token, if at least one of the new grounds of rejection was **not** necessitated by the amendment, then the office action cannot be properly made final.

Applying these rules to the present case, one finds that, because the § 101 rejection was not necessitated by Applicant’s amendment, the finality of the last office action is improper and should be withdrawn.

§ 101 Rejection

In paragraph 3, the Examiner rejected claims 1, 4-13, 36, and 39 under 35 U.S.C. § 101 as not falling within one of the four statutory categories.

In a memorandum dated 01/19/2009, John J. Love (Deputy Commissioner for Patent Examination Policy) explained that

under 35 USC § 101, a method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. As clarified in *Bilski*, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the “machine-or-transformation test.”

In view of this explanation, the Applicant directs Examiner’s attention to the following language in claim 1: “A method of processing data streams **in a contention-based WLAN system**, the method comprising ... (C) transmitting data corresponding to each of the two or more

sub-streams based on the assigned priority, wherein: the **contention-based WLAN system conforms to an IEEE 802.11e standard and supports a quality of service (QoS) facility.**” [Emphasis added.] These recitations clearly and positively tie claim 1 to a particular machine or apparatus, namely the wireless local-area-network (WLAN) system that conforms to an IEEE 802.11e standard and supports a quality of service (QoS) facility. Thus, claim 1 clearly satisfies the requisite “machine-or-transformation test” and, as such, falls within one of the four statutory categories.

For all these reasons, it is submitted that the rejection of claim 1 under 35 U.S.C. § 101 is improper and should be withdrawn. It is further submitted that the rejection of claims 4-13, 36, and 39 under 35 U.S.C. § 101 should be withdrawn at least because those claims variously depend from claim 1.

§ 103 Rejections

In paragraph 9, the Examiner rejected claims 1, 4, 10-11, 14, 17, 23, 26-27, 29, 31, and 35-42 under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Leeuwen. In paragraph 11, the Examiner rejected claims 5, 18, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Leeuwen and Chaddha. In paragraph 12, the Examiner rejected claims 6, 12-13, 19, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Leeuwen and Eshet. In paragraph 13, the Examiner rejected claims 7, 9, 20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Leeuwen, Eshet, and Balachandran. In paragraph 14, the Examiner rejected claims 8 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Leeuwen, Eshet, Balachandran, and Li.

For the following reasons, the Applicant submits that all pending claims are allowable over the cited references.

The rejections of claims 1, 4-14, 17-26, 29-31, and 35-42 under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Leeuwen are improper because (A) Leeuwen qualifies as prior art only under § 102(e) and (B) Leeuwen and the claimed invention were commonly owned at the time the claimed invention was made or subject to an obligation of assignment that would establish common ownership. As such, Leeuwen is not a proper prior-art reference (see 35 U.S.C. § 103(c) and MPEP 706.02(1)).

Removal of Leeuwen from the cited references renders the current rejections of claims 1, 4-14, 17-26, 29-31, and 35-42 under 35 U.S.C. § 103 substantively incomplete. Thus, withdrawal of these rejections is respectfully requested.

“Adapted To” Issue

In response to Examiner’s statements in paragraph 7 of the office action, the Applicant respectfully notes that § 103(a) rejections are supposed to address **prior-art** issues. Thus, if the Examiner wishes to object to the “adapted to” language, then a **formal** objection to that language or a rejection under 35 U.S.C. § 112 should be made. Presently, the propriety of the informal Examiner’s recommendations or “advice” regarding the “adapted to” language cannot be ascertained and, as such, cannot be properly addressed.

Next, the Applicant directs Examiner’s attention to MPEP § 2173.05(g) in general and to *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) in particular. These authorities approve “adapted to” clauses as acceptable and being in compliance with 35 U.S.C. § 112, second paragraph.

Finally, the Applicant reiterates that, on page 20 of the office action dated 05/28/2008, the Examiner explicitly and unequivocally stated that “Applicant’s arguments on previously raised

claim objections regarding use of the phrase ‘adapted to’ ... ha[ve] been noted and consequently the claim objections are **withdrawn**.” [Emphasis added.] Since the Examiner has not so far rescinded this statement on the record, the Applicant submits that no affirmative action is required from the Applicant on this point.

Conclusion

In view of the above remarks, the Applicant believes that all pending claims are in condition for allowance. Therefore, the Applicant believes that the entire application is now in condition for allowance, and early and favorable action is respectfully solicited.

Fees

During the pendency of this application, the Commissioner for Patents is hereby authorized to charge payment of any filing fees for presentation of extra claims under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17 or credit any overpayment to **Mendelsohn, Drucker, & Associates, P.C. Deposit Account No. 50-0782**.

The Commissioner for Patents is hereby authorized to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR § 1.136 for its timely submission, as incorporating a petition for extension of time for the appropriate length of time if not submitted with the reply.

Respectfully submitted,

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